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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,831	10/23/2003	John K. Junkers	2720	6670

7590 01/12/2005

Att.: Michael J. Striker
STRIKER, STRIKER & STENBY
103 East Neck Road
Huntington, NY 11743

EXAMINER

MITCHELL, KATHERINE W

ART UNIT PAPER NUMBER

3677

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/691,831	JUNKERS, JOHN K.	
	Examiner	Art Unit	
	Katherine W. Mitchell	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/21/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4 sheets</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-14 and cancellation of claims 15-16 in the reply filed on 10/21/2004 is acknowledged.

Information Disclosure Statement

2. Ref 2001/039858 on the IDS filed 1/15/04 is an invalid number. Examiner believes applicant intended 2001/0039858, and has listed that document on the included form 892.

Claim Objections

3. Claim 1 is objected to because of the following informalities: "the bolt" in line 5 lacks antecedent basis. Examiner assumes the object is the head of a bolt. Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/112101. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference of the resistive point and a breaking point is simply a matter of degree, and breaking would be an obvious variant of resistive, as the resistive point will break if enough axial force is applied. Reading in light of the specification, the resistive point is described as either physically breaking a projection, or breaking the frictional grip of two press fit parts; thus "break" does not require physical destruction of the nut material, but includes overcoming strong frictional resistance.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1,4, 7, 8,11, and 14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 31-34 and 25-26 of copending Application No. 10427103. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 10427103 application must inherently have a resistive point for the rotation of the washer and bolt to be stationary while the nut rotates. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Examiner notes that application 10/802890 includes details of the surface of the first and second face surfaces which at present prevent a problem with double patenting issues.

Claim Rejections - 35 USC § 102

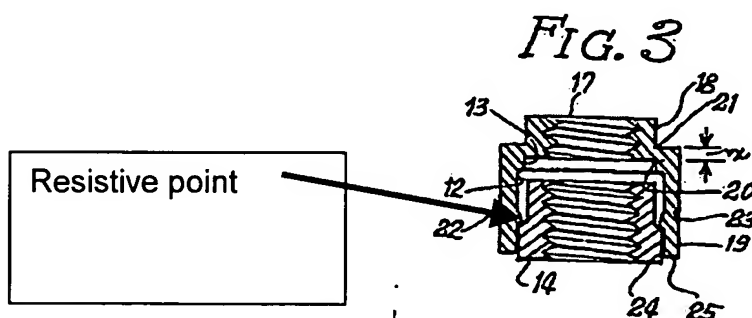
8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ward USP 1647409. Ward teaches in Figs 1 and 4 a fastener comprising a threaded bolt (1, Fig 1 and 2), a nut (2, Fig 1 and 2) screwable on said bolt, and a washer (4) having a body with a first and second bearing surfaces axially separated (Fig 1), at least one third turning resistant surface adapted to cooperate with bolt threads (washer threads 8, Fig 4), said body having at least one resistive point (7) such that the washer stops the bolt from turning when the nut is turned (lock washer, col 2 lines 56-72) and thereby creates a pull on the bolt which elongates the bolt in an axial direction and allows at least a portion (free end opposite 7) of said washer body to be axially pulled when the bolt elongates. The washer is capable of being applied between the nut and an object or bolt head.

10. Claims 1-6 and 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Grube GB 1330320.



Re claims 1 and 8: Grube teaches in Figs 3-7 a fastener comprising a threaded bolt (27), a nut (10/11) screwable on said bolt, and a washer (14) having a body with a first and second bearing surfaces axially separated (Fig 3), at least one third turning resistant surface adapted to cooperate with bolt threads (washer threads see Fig 3), said body having at least one resistive point (extending edge, see Fig 3 above for arrow pointing) such that the washer stops the bolt from turning when the nut is turned and thereby creates a pull on the bolt which elongates the bolt in an axial direction and allows at least a portion (internal surface with threads) of said washer body to be axially pulled when the bolt elongates. The washer is capable of being applied between the nut and an object or bolt head.

Examiner cannot determine if the resistive point / protrusions 22,23 on 10 break/deform, or if the resistive point / protrusions on 14 break/deform. If it is held that the resistive points on the nut, rather than the washer, are the resistive points which are overcome by axial force, it would have been obvious to one of ordinary skill in the art, having the teachings of Grube before him at the time the invention was made, to modify Grube to include resistive points on the washer instead of the nut, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Re claims 2-6 and 9-13: The body has 2 parts – the main part, and the protruding resistive point which initially prevents axial displacement of the main portion and then breaks under the action of the axial force. The two parts are integrally formed

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as one piece. Breaking is deforming. The formation is radially outwardly extending skirt shaped portion as shown in Fig 3. The skirt is considered knurl-shaped, as it is a small protuberance:

knurl (nûrl) *noun*

1. A knob, knot, or other small protuberance. ¹

Allowable Subject Matter

11. Claims 8 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims AND if proper terminal disclaimers are filed to overcome the obvious double patenting rejections above.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 703-305-6713. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell
Examiner
Art Unit 3677

Kwm
1/7/2004

A handwritten signature in black ink, appearing to read 'Katherine W Mitchell', is written over the printed name and title.